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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,643	08/18/2003	Ralf Schaffrath	10191/3168	5238
26646 7590 03/04/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER CARDENAS NAVIA, JAIME F				
ART UNIT 4182		PAPER NUMBER		
MAIL DATE 03/04/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/643,643

**Applicant(s)**

SCHAFFRATH ET AL.

**Examiner**

JAIME F. CARDENAS NAVIA

**Art Unit**

4182

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date August 18, 2003.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Introduction***

1. This **NON-FINAL** office action is in response to applicant's submission filed on August 8, 2003. Currently, claims 1-13 are pending.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on August 18, 2003 has been considered by the examiner.

***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figures 1-7 are informal and/or illegible. Further Figures 3 and 6, the graphs lack a title and descriptive axes and 5 and 7, the boxes and steps in the flowchart require additional description, possibly through descriptive text labels. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

4. **The drawings are objected to** because of minor informalities.

**Regarding Figures 3 and 6**, the graphs lack a title and descriptive axes.

**Regarding Figures 5 and 7**, the boxes and steps in the flowchart require additional description, possibly through descriptive text labels.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 2, 5, 11, and 13 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claim 2**, “necessary” is a relative term, which renders the claim indefinite. The term is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For purposes of examination, “necessary” has been interpreted as “sometimes”.

**Regarding claim 5**, “essential” and “necessary” are relative terms, which render the claim indefinite. The term is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For purposes of examination, “essential” and “necessary” have been ignored.

**Regarding claims 11 and 13**, it is unclear whether applicant is seeking to claim the electronic processing arrangement as part of a system or not, which would be changing statutory categories and make the claims improper.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 10-11 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A “computer program” does not fall into one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). Software, programming, instructions or code not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program’s functionality to be realized, the program will be statutory.

Examiner notes that applicant already has a properly claimed program product, method, and system performing the steps of the computer program, and suggests that these claims be cancelled. For purposes of examination, the computer programs of claims 10 and 11 have been treated as a program product.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 1-8 are rejected** under 35 U.S.C. 102(e) as being anticipated by Gajewski (US 2002/0120490 A1).

**Regarding claim 1**, Gajewski teaches:

A method for production planning, comprising:

subdividing a production planning sequence into individual sequence steps (par. 18, lines 1-3);

executing each of the individual sequence steps one after another (Figures 1A, 1B, and 1C); and

evaluating, after each of the individual sequence steps, a result of a preceding one of the individual sequence steps (Figures 1A, 1B, and 1C, the output of each step is an input for the next step, and so it is inherent that the results of each step are evaluated before being used).

**Regarding claim 2**, Gajewski teaches executing repeatedly each of the individual sequence steps if necessary (Figures 1A, 1B, and 1C, notice that some steps are labeled “recurring”).

**Regarding claim 3**, Gajewski teaches wherein the evaluating of the result of the preceding individual sequence step includes performing a static evaluation (Figures 1A, 1B, and



IC, the output of each step is an input for the next step, and so it is inherent that the results of each step are evaluated statically before being used).

**Regarding claim 4**, Gajewski teaches:

performing a market analysis (par. 19);  
executing a value design process (par. 23);  
setting up project premises (par. 20);  
performing a product analysis (par. 30);  
setting up a process graph (par. 31);  
setting up a structural concept (par. 44);  
working out a manufacturing concept (par. 91); and  
setting up a rough layout (par. 105).

**Regarding claim 5**, Gajewski teaches wherein the project premises include essential project premises and necessary project premises (par. 20, “vehicle system assumptions and timing and vehicle segment wants with QFD” are premises).

**Regarding claim 6**, Gajewski teaches performing an additional evaluation after setting up the rough layout (par. 106).

**Regarding claim 7**, Gajewski does teaches wherein the performing of the additional evaluation is performed as a dynamic and stochastic evaluation (par. 106, trade-off analysis is dynamic, risk analysis is stochastic).

**Regarding claim 8**, Gajewski teaches wherein the method is performed and linked into a product development process (see claim 1 for reference and rationale. Claim 1 teaches the method being performed and the method is a product development process).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 9-13 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Gajewski (US 2002/0120490 A1).

**Regarding claim 9**, Gajewski teaches the steps performed by the system (see claim 1 for reference and rationale).

Gajewski does not teach an interface and a processing unit for performing the steps.

It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of subdividing a production planning sequence into individual sequence steps gives you just what you would expect from the manual step as taught by Gajewski. In other words there is no enhancement found in the claimed step. The claimed step only provides automating the manual activity. Likewise, automating the executing and evaluating steps gives just what one would expect from the manual steps taught by Gajewski. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

Thus, it would have been obvious to combine the teachings, motivated by the advantage in time savings brought on by the addition of a processing unit and interface.

**Regarding claims 10-13**, they are rejected using the same art and rationale used above for rejecting claim 9. This is because claims 10-13 claim a computer program, computer program product, and corresponding electronic processing arrangement performing the method performed by the system of claim 9.

*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Mujtaba et al. (US 2003/0115090 A1) teaches an integrated plan for manufacturing and marketing which includes analysis of market demand, static and dynamic data, and premises.

Juras et al. (US 2002/0165744 A1) teaches product and manufacturing development.

Emori et al. (US 7,058,465 B2) teaches developing detailed estimates of cost and time for production of sheet metal working.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAIME F. CARDENAS NAVIA whose telephone number is (571)270-1525. The examiner can normally be reached on Mon-Fri, 7:30AM - 5:00PM EST, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571) 272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 12, 2008

/JAIME CARDENAS-NAVIA/  
Examiner, Art Unit 4182

/Thu Nguyen/  
Supervisory Patent Examiner, Art Unit 4182